

1. (Amended) An article comprising:
a disk with a circular opening in the center of the disk; and
a fastener adapted to concentrically attach the disk to a particle outlet
opening of a classifier wheel.

22. (Amended) A kit comprising:
a disk with a circular opening in the center of the disk; and
at least one fastener adapted to attach the disk to the particle outlet
opening of a classifier wheel.

REMARKS

The Office Action of March 16, 2001 has been carefully considered. Reconsideration and allowance of this application are respectfully requested in view of the following remarks.

Claims 1-23 are pending in the present application.

Claims 1-23 are rejected.

INFORMATION DISCLOSURE STATEMENT

With respect to the Examiner's rejection of the information disclosure statement, a PTO-1449 was sent to the USPTO with the application to accompany the listing of the patents in the Specification. A copy of the PTO-1449 is attached.

Specification

With respect to the Examiner's rejection to the title, the title has been amended.

CLAIM REJECTIONS - 35 U.S.C. §112

Claims 1-9, 22 and 23 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim

the subject matter which applicant regards as the invention, which rejection is traversed.

According to the Examiner, Claims 1 and 22 recite "the particle outlet opening" in line 3, and there is insufficient antecedent basis for this limitation in the claims.

While in disagreement claims 1 and 22 have been slightly changed as suggested by the Examiner, and which changes do not relate to patentability and which changes do not affect the scope of the claims.

CLAIM REJECTIONS - 35 U.S.C. §102

Claims 1, 4-9, and 22 were rejected under 35 U.S.C. 102(b) as being anticipated by either of references 2,754,967 or 2,367,906. This rejection is traversed since the Examiner has not pointed out to Applicant where in the prior art the combination of the rejected claims is specifically disclosed, for example, an article in accordance with claim 1 further comprising a lip or rim adjacent to the circular opening which has a thickness of from about 1.5 to about 5 times the thickness of the disk.

For each and every claim rejected, the Examiner must point out where in the reference the material element(s) of each rejected claim is disclosed. It must appear that every material element of the claim in question was disclosed by a single prior art reference. Mueller Brass Co. v. Reading Industries, Inc., 352 F. Supp. 1357, 1367 (E.D. Pa. 1972), aff'd, 487 F.2d 1395 (3d Cir. 1973).

CLAIM REJECTIONS - 35 U.S.C. §103

Claims 1, 4-9, 10-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over 4,786,406 in view of 2,367,906, which rejection is traversed.

The Examiner has not established a prima facie case of obviousness with respect to the Nied patent, 4,786,406 or the Wall patent, 2,367,906, since for example, there is no suggestion to locate the disk on the classifier wheel.

The Examiner has the burden under section 103 to establish a prima facie case of obviousness. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fine, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988).

The Examiner has failed to point out any objective teaching that would lead one of ordinary skill in the art to combine the disclosure of the Nied patent with the Wall patent. As the Examiner has stated, the Nied patent does not disclose a removable disk position on the classifier wheel. The Examiner states further that in the prior art "the disks are usually attached to the non-rotating exit-conduit elements downstream of the wheel", not on the classifier wheel of the present invention.

Neither of the cited references suggests or teaches the desirability of combining the elements of the present invention as claimed. Obviousness cannot be established by combining references to arrive at the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. In re Geiger, 2 U.S.P.Q. 2d 1276 (Fed. Cir. 1987); Carella v. Starlight Archery and Pro Line Co., 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. (BNA) 929 (Fed. Cir. 1984).

As the Court of Appeals for the Federal Circuit recently stated in Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal Inc., 56 USPQ2d, 1641 (Fed. Cir. 2000) at 1644:

This court has recently reemphasized the importance of the motivation to combine:

As this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner [or accused infringer] may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting

patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

....

... To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.

In re Rouffet, 149 F.3d 1350, 1357-58, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted).

For the instant application, the Examiner also appears to have attempted to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. This method is clearly impermissible. Nothing in any of the cited references teaches or suggests the combination of elements recited in the instant claims.

One must avoid reading the applicant's statements into the prior art, without the benefit of the applicant's disclosures, would make the invention as a whole obvious. In re Spinnoble, 160 U.S.P.Q. 237 (CCPA 1969).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2D (BNA) 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 U.S.P.Q.2D (BNA) 1635, 1637 (Fed. Cir. 1998); In re

Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996).

The rejection of claims under 35 U.S.C. § 103 as being unpatentable over the cited references, alone or in combination, for at least the above reasons, is believed to be overcome and should be removed.

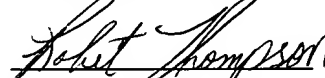
Also, the references lack one or more of the aforementioned claimed elements as pointed out above, such as, locating the disk on the classifier wheel additionally or alternatively, the reference lack any reasonable teaching or suggestion, of a removable disk located on the classifier wheel. Thus, the rejected claims of the present invention are not obvious over the teachings of the cited references. The reference provide no motivation or suggestion to one of ordinary skill in the art to select the elements of the claimed invention, contrary to the conclusion suggested by the Examiner.

It is noted that the drawings have not been objected to by the Draftsperson.

In the event the Examiner considers personal contact advantageous to the disposition of this case, the Examiner is hereby authorized to call Applicant's Attorney, Robert Thompson, at Telephone Number (716) 423-2050, Rochester, New York.

No additional fee is believed to be required for this amendment and no transmittal form is included. However, the undersigned Xerox Corporation Attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE:

IN THE SPECIFICATION:

The new title is: Article and Apparatus for Particulate Size Separation

IN THE CLAIMS:

1. (Amended) An article comprising:
 - a disk with a circular opening in the center of the disk; and
 - a fastener adapted to concentrically attach [the] a disk to a particle outlet opening of a classifier wheel.

22. (Amended) A kit comprising:
 - a disk with a circular opening in the center of the disk; and
 - at least one fastener adapted to attach the disk to the [fine] particle outlet opening of a classifier wheel.